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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,577	12/21/2001	Peter Schertl	Mo6856/LeA 33,769	1797

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EXAMINER
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RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/019,577

Applicant(s)

SCHERTL ET AL.

Examiner

Rob Rábago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Prior objection to claim 10, as well as prior rejections under 35 USC 112(2) are withdrawn in view of amendment. Rejections over Grubbs '785 are withdrawn in view of amendment. Rejection over Throckmorton '244 is withdrawn in view of amendment.

#### ***Claim Objections***

2. Claims 1, 5, 13 and 16 are objected to for the following informality. In each claim, it would appear that the word "with" in the phrase "b is an integer with that ..." is superfluous and should be deleted.

#### ***Claim Rejections - 35 USC § 102***

3. Claims 1-10 and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawasaki et al. (US 3,755,275) for the reasons set forth in item 7 of the Office action mailed 6/20/2003. However, in view of the amendment filed 9/24/2003, reliance is limited to reference examples 10, 11 and 12.

Applicant's arguments filed 9/24/2003, which rest entirely on the amended scope of transition metal complexes, have been fully considered but they are not persuasive because the narrowed scope of monomers and catalysts are still anticipated by the cited examples. Specifically, the amendment has limited the monomers to a specific named set, and has limited the transition metal catalyst to one comprising multidentate

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ligand L (in quantity "a") and at least one monoanionic or non-ionic ligand Q (in quantity "b"). The reference examples polymerize acrylonitrile and butadiene using a trisacetylacetonovanadium complex, wherein the acac ligand is a monoanionic bidentate ligand. Since the monomers are within the claimed set, and the presence of three acac ligands satisfies both the L and Q substituents when  $a=1$  or  $2$  and  $b=1$  or  $2$ , the cited examples are within the scope of the amended claims.

4. Claims 1-11 and 13-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuntz (US 4,175,017).

The reference shows in example 1 the copolymerization of ethyl acrylate, isobutylene and butadiene using a catalyst comprising  $\text{VOCl}_3$ ,  $\text{AlEtCl}_2$  and lauroyl peroxide (col. 7, line 61 through col. 8, line 19), further stating that the butadiene units are inserted randomly (col. 8, line 63). Example 2 goes on to use the example 1 copolymer in an apparatus to produce molded forms of the copolymer. Although the cited examples do not use a transition metal complex within the newly claimed scope, patentee has disclosed a list of only seven specific vanadium complexes at col. 5, lines 22-25, two of which are within the claimed scope.  $\text{VCl}_4$  corresponds to the claimed complex when  $a=0$  and  $b=4$ , and  $\text{V}(\text{AcAc})_3$  corresponds to the claimed complex because the acac ligand is a monoanionic bidentate ligand which satisfies both the L and Q substituents when  $a=1$  or  $2$  and  $b=1$  or  $2$ . The disclosure of two compounds from a field of seven is anticipatory within the meaning of 35 USC 102, as the reference is

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clearly directing the ordinary skilled worker to use any of the seven vanadium complexes in methods analogous to those shown in the working examples.

Regarding the limitations of claims 2 and 9, the claimed mechanism is merely the same proposed mechanism by which conventional transition metal-based insertion polymerizations are believed to take place, and therefore such a mechanism would be inherently present in the methods disclosed in the reference. The burden of proof is shifted to applicants to show that the applied reference examples do not contain the claimed mechanism. *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

#### ***Allowable Subject Matter***

5. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art cited on this record has not disclosed or suggested the making of an adhesive using the specified copolymer with all of the properties which would necessarily result from using the copolymerization method specified in claim 13.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rábago whose telephone number is (703) 308-4347. The examiner can normally be reached on Monday - Friday from 8:30 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ROBERTO RABAGO  
PATENT EXAMINER

  
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RR  
November 19, 2003